

Remarks/Arguments:

I. Status

The Office Action dated March 27, 2009 (the “Office Action”), has been carefully reviewed. Claims 1, 7, 9-10, 12-13, 15, 23-24, and 26-27 have been amended and claims 1-28 are pending in this application. Entry of the foregoing amendments and reconsideration of this application is respectfully requested.

II. 35 U.S.C. § 112 Rejection

The only basis for rejecting the claims 1-28 is under 35 U.S.C. § 112, for failing to particularly point out and distinctly claim the invention. (Office Action at page 3). Specifically, the claims were rejected for inclusion of the terms “high speed image” and “high speed imaging.” (Office Action at page 3). By the foregoing amendments, the identified terms have been removed from the claims. Therefore, the sole basis for rejection of the claims has been overcome.

III. New Limitation is Not Disclosed by Prior Art

MPEP 2173.06 states that even when a rejection under 35 U.S.C. § 112, for failing to particularly point out and distinctly claim the invention, is made, any other rejections based upon lack of patentability over the prior art are also to be made. The Office Action did not, however, include a rejection of the claims as obvious over U.S. Patent No. 5,640,242 to O’Boyle (hereinafter “O’Boyle”). Presumably, the obviousness rejection was not repeated because the Board of Patent Appeals and Interferences decision dated October 31, 2007 (the “Decision”) noted that whatever meaning is given to the term “high speed image,” the system of O’Boyle is not necessarily capable of such

imagery. (Decision at page 4). By entry of the amendments set forth above, the distinction between O'Boyle and the present claims identified by the Board is no longer valid. The claims have been amended, however, to include a limitation which is definite and which distinguishes the present claims over the disclosure of O'Boyle.

Specifically, claim 1 has been amended to incorporate the limitation of "acquiring an image of a particular area of the substrate while the substrate is moving at a speed of at least 200 lineal feet per minute" and the remaining independent claims have been amended to include, for purposes of this discussion, the same limitation. Thus, each of claims 1-28 includes the "200 lineal feet per minute" limitation. As noted by the Dissent in the Decision, cameras capable of obtaining images of objects moving at a speed of at least 200 lineal feet per second were well known by those of ordinary skill in the art at the time of the filing of the Applicant's specification. (See Decision at pages 11-12). Therefore, the "200 lineal feet per minute" limitation is both definite and enabled.

Moreover, the limitation of obtaining an image while the substrate is moving at the recited speed or faster is not disclosed by the prior art of record. Specifically, while the Board's discussion of O'Boyle focused initially on the lack of teaching of a CCD speed (see Decision at page 4), the same discussion applies to the speed of the substrate in the O'Boyle device at the time the image is obtained. The Applicant has not, however, identified any disclosure in O'Boyle indicating that the object is moving at all during imaging, much less moving at the speed required by the claims.

By the foregoing amendments, the issue of O'Boyle's "frame grabber," raised by the Board in the Decision, is also rendered moot. (Decision at page 4). To wit, regardless of the frequency with which a frame is obtained by the frame grabber, O'Boyle is still silent as to any movement of the substrate during the imaging operation.

Likewise, the discussion of the “CMP process” claim terminology found at pages 4-5 of the Decision is moot in view of the limitations added by the present Amendment.

Therefore, claims 1-28, as amended, are not obvious over O’Boyle for substantially the same or analogous reasons identified by the Decision.

IV. Support for New Limitation

Each of claims 1-28 includes a limitation directed to imaging of a substrate which is moving at a speed of at least 200 lineal feet per minute as discussed above. Support for this limitation in the specification as originally filed is found at page 4, lines 20-22, page 7, lines 18-20, and page 14, lines 12-14. Accordingly, no new matter is introduced by way of this amendment.

V. Conclusion

Applicant respectfully requests entry of the amendments and favorable consideration of the application.

A prompt and favorable action on the merits is requested.

Respectfully Submitted,
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